

Appl. No. 09/697,554  
Reply to Office Action of October 29, 2003

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-32 are presented for examination. Claims 1, 9, 14, 19, and 23 have been amended to clarify that the claimed set top box (STB) is for receiving a television satellite broadcast signal and supplying television program data corresponding to the received television satellite broadcast signal to a display device and not simply a computer and to further clarify the external connection between the STB, the display device, and the game executing device that are clearly supported by the description of FIG. 1, at page 17, lines 1-24 of the specification, for example.

The outstanding Office Action presents a rejection of Claims 1 and 3-18 under 35 U.S.C. § 102(b) as being anticipated by Crawford (U.S. Patent No. 5,771,354) and a rejection of Claims 2 and 19-32 under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Internet Explorer (web browser, copyright 1991-2001).

Before discussion the outstanding prior art rejections, it is again believed that the brief review of the present invention set forth in the last response would be helpful. In this regard, the present invention is directed to a game machine system that allows a user to enjoy games according to supplied game software in their own home at a low cost. The game machine system provides a game executing device for executing gaming commands, a television receiver serving as a display device, and a set top box (STB) that receives a television satellite broadcast signal to supply television program data corresponding thereto to the television receiver serving as the display device. The STB is provided with a server device. The STB,

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display device, and the game executing device forming the game machine system are connected to each other via a digital communication line that is external to each of these devices. The STB including the above-noted server can receive game software transmitted to it via digital broadcasting services and can store received game software on a hard disk internal of the STB. The game machine can then execute a game by accessing the hard disk to read the game software as required. The image generated by the game machine and background image data output from the STB server are supplied to the display television receiver via the digital communication line so that a game image including background can be displayed and the game played.

Turning to the outstanding rejection of Claims 1 and 3-18 as being anticipated by Crawford, it is noted that the requirements of independent base Claims 1, 9, and 14 have been ignored in many instances. For example, each of these independent claims (and the claims dependent thereon) require a set box top (STB) and a digital communication line that is external to each of the STB, a display device, and a game executing device that interconnects these devices to form a game machine system.

The outstanding Action (at page 2) first errs by attempting to unreasonably equate any computer associated in any manner with a cable TV system to an STB as if the meaning of STB to the artisan and the meaning established by the disclosure are of no concern. To insure that the PTO can no longer place unreasonable reliance upon its outlandish assertion that any computer associated in any manner with a cable TV system can be said to perform as an STB, the implied STB function of receiving a television satellite broadcast signal and supplying television program data corresponding to the received television satellite broadcast signal to a display

device has been added to all of the pending claims. Clearly, the attempted reading of computer 50(Z) as being a STB fails because computer 50(z) cannot receive a television satellite broadcast signal and supply television program data corresponding to the received television satellite broadcast signal to a display device.

Moreover, the outstanding Action further commits clear error in ignoring that independent base Claims 1, 9, and 14 required more than a digital communication line that is external to a server device, a display device, and a game executing device for supplying game software to a computer. This inaccurate paraphrasing of the actual claim language does not change that actual claim language or the long established requirement that the PTO must consider the actual words of the claims. See In re Wilson, 165 USPQ 494, 496 (CCPA 1970) requiring that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” What independent base Claims 1, 9, and 14 actually recited was that the digital communication line that is external to the server device, the display device, and the game executing device was also what connected these devices together (“connected to each other via a digital communication line”).

The present amendment to Claim 1 emphasizes that the STB, the display device, and the game executing device are “connected to each other to form the game machine system via a digital communication line that is external to each of the STB, the display device, and the game executing device,” with similar language in independent Claims 9 and 14. If the PTO is to continue to allege that external lines 150 that do not connect any of display 54, processor 68 inside computer 52, or computer 52 “to each other” can be read as the claimed digital communication line, it must explain how it arrives at this seemingly impossible conclusion

under the dictates of In re Lee, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) that obligate “the agency to make the necessary findings and to provide an administrative record showing the evidence on which the findings are based, accompanied by the agency's reasoning in reaching its conclusions” (emphasis added, citation omitted). Also, note MPEP §707.07(f) requires that an applicant’s actual argument be answered, not a simplified modification that has nothing to do with that actual argument as at the top of page 6 of the outstanding Action.

Moreover, and as noted in the last response, if the PTO finds a teaching in Crawford that the processor 68, internal of computer 50, is connected to the display monitor 54, also internal of computer 50, by the communications lines 150, despite the showings of Figs 1 and 3 and the admission at page 6 of the outstanding Action that communication line 150 cannot connect internal portions 68 and 54 together because it is external to computer 50 housing these elements, it must point to where in Crawford it finds this teaching. See In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (“When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference.”).

As Claims 3-8, 10-13, and 15-18 depend ultimately from one or the other of independent Claims 1, 9, and 14, they include the above-noted limitations of these independent claims that are clearly not taught or suggested by Crawford. In addition, these dependent Claims 3-8, 10-13, and 15-18 all include additional recitations that are not taught or suggested by Crawford and, accordingly, cannot be said to be anticipated by Crawford for this reason as well.

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Furthermore, and as noted in the last response, the outstanding Action again inappropriately attempts to lift the description of the prior art at column 2, lines 15 and 16 and transpose it into the disclosure of the Crawford system of Figs. 1 and 3 without any statement by Crawford that the download of new video games provided by the noted information providers is to be incorporated into the improved and different on-line service that Crawford proposes. The Crawford teaching is of a system for "executing host based software on the remote user's system directly or for a user's locally executing application to directly access storage on the host system," see col. 7, lines 56-60, with no mention that the downloading of video games is to be included in the Crawford system to be found here or elsewhere in Crawford.

In this last regard, the question is not the "obviousness" under 35 U.S.C. §103 of adding the downloading of new video as noted relative to previous service providers to the Crawford taught system, it is instead where the Crawford teaching of inclusion of video game downloading as a part of the Crawford system can be found in Crawford. Thus, the mere mention of a video game downloading service as a previously provided service is still not seen to be a teaching that this service is to be included in the system proposed by Crawford.

This argument is based on the established case law that requires anticipation by a single reference that shows the claimed subject matter in the claimed arrangement that was noted in the last response relative to In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990); Ex parte Gould, 6 USPQ2d 1680 (Bd. Pat. App. & Int. 1987); and Ex parte Osmond, 191 USPQ 334 (Bd. Pat. App. & Int. 1973). Clearly, what Crawford teaches to be included into the system and available for a fee is the question that must be addressed as to anticipation and not whether the artisan would have been motivated to include downloading of video game software as done by other providers,

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a different question under 35 U.S.C. §103 that requires that evidence of motivation must also be shown.

Accordingly, the anticipation rejection applied to Claims 1 and 3-18 is traversed for all the above-noted reasons.

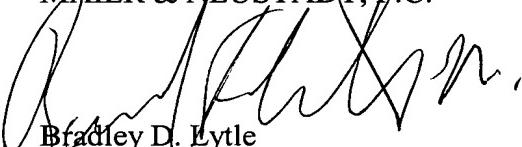
Turning to the obviousness rejection of Claims 2 and 19-32, it is noted that the Internet explorer browser software is again relied upon for the inclusion therein of the Joint Picture Expert Group (JPEG) image format which is once more simply alleged in the Action to have been developed at least as early as 1997. However, there is nothing alleged in the outstanding Action as to the Joint Picture Expert Group (JPEG) image format and/or the Internet Explorer (web browser, copyright 1991-2001) that cures any of the deficiencies noted above as to Crawford. Accordingly, as each of Claims 2 and 19-32 also requires the above-noted set top box (STB) receiving of a television satellite broadcast signal with the received television satellite broadcast signal being supplied to a display device as well as a digital communication line that is external the "display device," the "game executing device," and the "STB" that also serves to connect each one of these devices "to each other" (emphasis added), and as there has been no presentation of any evidence showing this claim structure and corresponding claim steps, this rejection of Claims 2 and 19-32 is traversed as lacking establishment of the required *prima facie* showing of obviousness.

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Accordingly, as no other objections or rejections remain outstanding, it is believed that this application is clearly in condition for formal allowance and an early and favorable action to this effect is, therefore, respectfully requested.

Respectfully submitted,

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